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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,761	10/01/2001	Robert Cregg Barnes	P07353US00/MP	6832
881	7590	09/09/2005	EXAMINER	
STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			HYLTON, ROBIN ANNETTE	
			ART UNIT	PAPER NUMBER
			3727	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/966,761
Filing Date: October 01, 2001
Appellant(s): BARNES ET AL.

MAILED
SEP 09 2005
Group 3700

Marvin Petry
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 6, 2005 appealing from the Office action mailed November 4, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

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(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-2, 4-6, 9-11 and 14-19 are rejected and on appeal.

Claims 3 and 8 are objected to as being dependent on a rejected base claim but allowable if rewritten in independent form.

Claims 7 and 12-13 have been canceled.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Des. 321,788	CHEN	11-1991
3,419,198	PETTERSEN	12-1968

Prior Art Drawings of "Polo" container.

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United Business Media, "Mini Pack Marks 50 Years of Polos" Packaging Magazine, (June 18, 1998), p. 5.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,2,4-6,9-11, and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polo in view of Pettersen (US 3,419,198).

Polo teaches the claimed container except for the tab extending less than 90° or 180° around the top surface of the container body.

Pettersen teaches it is known to provide a hinged tab having a depressible actuator on a container, the tab extending less than 180° and less than 90° around the container body.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a smaller tab to the container of Polo. Doing so provides a more stable closure mechanism having greater resistance to being inadvertently torn from the body.

Claims 16,18,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US Des. 321,788).

Chen teaches a container having an outer wall and an inner wall forming a hollow body, especially when the tabs are closed. A single open tab uncovers an aperture in the hollow body and extends around the top of the container less than 180°. Chen does not teach a true toroid shaped body.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the inner and outer side walls of a smooth round shape since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Polo.

Chen as modified teaches the claimed container except for concave upper and lower walls of the body.

Polo teaches it is known to provide concave upper and lower walls to a container body.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of concave upper and lower body walls to the modified container of Chen. Doing so provides a more rounded container having no sharp edges.

(10) Response to Argument

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the tab having a hinge disposed on a plane of the container extending from the central portion to the outer diameter such that the tab extends in a circumferential direction less than 180°) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims do not set forth a direction of extension with respect to the opening direction of the tab or the position of the hinge, but merely set forth a tab extending around the top of the container less than 180°. To that degree, the tabs of both Polo and Pettersen extend in the circumferential direction. Appellant has not clearly distinguished the *claimed* invention from that of the prior art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

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knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references are combinable since one of ordinary skill in the art at the time the invention was made would utilize the teaching of one prior art reference (Pettersen) having a small tab extending less than 180° around the container to modify a container having a tab extending at least 180° around the container. The modification is not to change the orientation of the tab, but the size of the tab. Changing the size of the tab is an obvious modification to one of ordinary skill in the art and does not change the orientation of the tab with respect to the hinge and container as asserted by appellant.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the tab having a hinge disposed on a plane of the container extending from the central portion to the outer diameter such that the tab extends in a circumferential direction less than 180°) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims merely set forth a tab extending around the top of the container less than 180°. The claims do not set forth a direction of extension with respect to the opening direction of the tab or the position of the hinge. Therefore, the container of Chen meets the limitation since any one of the tabs of Chen extends around the top of the container less than 180° as is clearly seen in any of the figures.

With respect to the shape of Chen being changed from heptagonal to toroidal, appellant argues the hinge of Chen must be formed as a straight line. It is submitted that one of ordinary skill in the art at the time the invention was made would in fact modify the container of Chen by

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smoothing the edges and forming the hinges in a known manner to provide a smooth outer edge. This would in fact eliminate the straight line hinge of Chen. Although not relied upon in the rejection, this is evidenced by the hinge structure seen in the embodiment depicted in figures 1-5 of Pettersen.

Regarding the ornamental design of Chen, ornamental designs are known to be modified by changing various ornamental features of the item depicted therein, including the shape of the object.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Robin A. Hylton
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